Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RON D. STORER

Appeal No. 2000-1477
Application No. 08/654,739

ON BRIEF

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-16, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a grille guard for a vehicle. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Go Rhino! Catalog 960, pages 1-8, 1996 (Go Rhino)

Claims 1-16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Go Rhino.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 23) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 22) and Reply Brief (Paper No. 24) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant's invention relates generally to grille guards for vehicles, and more particularly to a grill guard having a footstep for enhancing the access to the hood and engine compartment of trucks and sport utility vehicles, which often are high off of the ground. As manifested in independent claim 1, the invention comprises at least one horizontal grille guard member, at least one vertical grille guard member attached to the horizontal member, and a footstep attached to the vertical member proximate a lower end thereof in such a fashion, and of such construction, as to support the weight of a person. The step comprises a generally tubular horizontal member formed of a material sufficient to resist bending under a person's weight, and an integrated flattened portion formed on the tubular member for providing a user with a structural "visual queue"[1] that the flattened portion is to be used for stepping upon.

The examiner has taken the position that the subject matter of claim 1 is unpatentable over the grille guard shown on page 3 of Go Rhino. In arriving at this conclusion, the examiner expresses the view that the lowermost horizontal component shown in the illustration is "capable" of being used as a step, and that it would have been obvious to one of ordinary skill in the art to form it as a tubular member having an integrated flattened portion in view of the steps shown on the side of the truck on page

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[1]It appears to us that "queue" should be "cue," in that the common applicable definitions of the former seem to be far removed from the meaning the appellant attaches to it, while that of the latter is "a feature indicating the nature of something perceived." Merriam Webster's Collegiate Dictionary, Tenth Edition, 1996, pages 958 and 282.

7, because it would be "a matter of design preference, dependent upon such factors as cost and material availability or aesthetic purposes," and would provide greater strength (Answer, page 4). We do not agree.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even if one accepts, arguendo, the examiner's conclusion that the lower horizontal member in Figure 3 of Go Rhino is capable of supporting the weight of a person, it clearly does not meet the terms of the claim, in that it is not a generally tubular member having an

integral flattened portion that provides the user with the visual impression that it is a step, and we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify it in the manner proposed by the examiner. The appellant has argued in the Brief that there are specific reasons for the claimed structure, and the examiner has provided no persuasive reasons why the artisan would have found suggestion in the structure of a truck cab entry member to provide a step of the type claimed on a grille guard, or evidence in support of the conclusions set forth on page 4 of the Answer. In fact, a close scrutiny of the truck entry step pictured on page 7 reveals that it is not a generally cylindrical tubular member having a flattened portion formed therein, and therefore even if it were incorporated into the selected grille design, the result would not be the structure required by claim 1.

From our perspective, the only suggestion for modifying the grille guard in the manner proposed by the examiner is found in the hindsight afforded one who first viewed the appellant's disclosure. This, of course, is not a proper basis for a rejection under 35 U.S.C. § 103. In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

In sum, Go Rhino does not establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and we thus will not sustain the rejection of claim 1 or, it follows, of claims 2-8, which depend therefrom.

Independent method claim 9 also contains the same limitations, and further requires that the flattened portion be formed by pressing the tubular member, a limitation about which the examiner has made no comment. For the reasons expressed above with regard to claim 1, the rejection of claims 9-16 also is not sustained.

Although we did not need to address Mr. Storer's declaration in the course of evaluating the examiner's rejection, we wish to comment in passing that we are impressed by the fact that the claimed grille guard captured the major portion of the market from the traditional grille guard over the course of a few years.

SUMMARY

The rejection is not sustained.

The decision of the examiner is reversed.

NEAL E. ABRAMS Administrative Patent Judge	)))))) BOARD OF PATENT
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